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09/805,534	03/13/2001	Brian M. Siegel	SONY 3.0-026	2120

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EXAMINER
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LEROUX, ETIENNE PIERRE

ART UNIT	PAPER NUMBER
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2171

13

DATE MAILED: 04/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/805,534

Applicant(s)

SIEGEL ET AL.

Examiner

Etienne P LeRoux

Art Unit

2171

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 15 March 2004.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1, 2, 4-9, 12 and 14-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4-9, 12, and 14-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 March 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

***Specification Objection***

The disclosure is objected to because of omission of the following:

(a) Background of the Invention

1. Field of the Invention

2. Description of the Related Art including information disclosed under 37 CFR

1.97 and 1.98.

Appropriate correction is requested.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 4-9, 12 and 14-18 are rejected under 35 U.S.C. 102(b) as being anticipated by US Pat No. 5,913,210 issued to Call (hereafter Call '210).

Claim 1:

Call '210 discloses:

- associating a first code [universal product code and first Internet address per col 3, lines 48-60] with a first characteristic of a product and a second code [universal product code and second Internet address per col 3, lines 48-60] with a second characteristic of the same product,

Art Unit: 2171

- storing a first characteristic value associated with the first characteristic and a second characteristic value associated with the second characteristic [registration handler, Fig 2, item 203]
- associating the identity of a first entity with at least one of the codes including setting one or more update values indicating whether an entity is authorized to receive changes relating to the first or second characteristics associated with the code [col 3, lines 48-60],
- changing at least one of the characteristic values [col 4, lines 34-37, col 6, lines 22-30, col 8, lines 32-42],
- retrieving the identity of the first entity based on the changed value and one of the one or more update values [col 6, lines 31-42, col 10, lines 46-56]
- sending the changed value to the first entity [col 3, lines 48-55, col 8, lines 32-42, col 6, lines 31-42]

Claim 4:

Call '210 discloses sending the change by email [col 4, lines 44-52 and col 7, lines 7-10]

Claim 5:

Call '210 discloses retrieving the electronic address of the first entity [col 4, lines 10-26]

Claim 6:

Call '210 discloses:

- providing product data associating information codes to information about a product [col 3, lines 48-60],
- providing destination data correlating the information codes to entities [col 4, lines 10-26],
- storing an entity - data association [
- modifying the information about the product [col 4, lines 34-37, col 8, lines 32-42]

Art Unit: 2171

- identifying a first entity based upon the information code associated with the information about the product, the product data and the destination data [col 3, lines 48-60]
- transmitting the modified information about the product to the first entity [col 3, lines 48-55 and col 8, lines 32-42]

Claim 7:

Call '210 discloses wherein the modified information is transmitted over a network and the first entity is a computer on the network [Fig 1, items 120 and 103]

Claim 8:

Call '210 discloses wherein the network is the Internet [col 2, lines 28-33]

Claim 9:

Call '210 discloses wherein the product is a service [col 2, lines 33-47]

Claim 12:

Call '210 discloses:

- means for associating a first code [first Internet address per col 3, lines 48-60] with a first characteristic of a product and a second code [second Internet address per col 3, lines 48-60] with a second characteristic of the same product,
- means for storing a first characteristic value associated with the first characteristic and a second characteristic value associated with the second characteristic [Fig 2, item 203]
- means for associating the identity of a first entity with at least one of the codes [col 3, lines 48-60],  
means for changing at least one of the characteristic values [col 4, lines 34-37 and col 8, lines 32-42]

Claim 14:

Art Unit: 2171

Call '210 discloses wherein the means for sending the changed value comprises means for sending the value by email [col 7, lines 7-30].

Claim 15:

Call '210 discloses:

- a processor [Fig 1, item 103]
- data instructions [Fig 1, item 103] executable by the processor, the instructions including:
- associating a first code with a first characteristic of a product and a second code [second Internet address per col 3, lines 48-60] with a second characteristic of the same product [first Internet address per col 3, lines 48-60];
- storing a first characteristic value associated with the first characteristic and a second characteristic value associated with the second characteristic [Fig 2, item 203]
- associating the identity of a first entity with at least one of the codes [col 3, lines 48-60];
- changing at least one of the characteristic values [col 4, lines 34-37, col 8, lines 32-42];
- retrieving the identity of the first entity based on the association with the code associated with the characteristic with the changed value [col 6, lines 31-42];
- sending the changed value to the first entity [col 6, lines 31-42]

Claim 16:

Call '210 discloses wherein the system comprises a server connected to a network and the first entity comprises another server on the network [col 3, line 60 through col 4, line 10]

Claim 17:

Call '210 discloses wherein the system comprises a server connected to a network, the data is maintained by a seller, and the first entity is a buyer of the product from the seller [Fig 1 and abstract].

Art Unit: 2171

Claim 18:

Call '210 discloses wherein the product is a service [col 2, lines 33-47]

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over US Pat No 5,913,210 issued to Call (hereafter Call '210).

Claim 2:

Call '210 discloses the elements of claim 1 as noted above.

Call '210 fails to disclose associating the identity of a second entity with the same code as that associated with the first entity, retrieving the identity of the second entity based on the code associated with the characteristic having the changed value, and sending the changed value to the second entity.

However, Call '210 discloses the product codes and the Internet addresses are provided by or on behalf of participating manufacturers and suppliers [col 2, lines 50-52].

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Call '210 to include associating the identity of a second entity with the same code as that associated with the first entity, retrieving the identity of the second entity based on the code associated with the characteristic having the changed value, and sending the changed value to the second entity.

The ordinarily skilled artisan would have been motivated to modify Call '210 per the above for the purpose of controlling the scope and content which a manufacturer makes available [col 8, lines 32-35].

### ***Response to Arguments***

Applicant's arguments filed 3/15/2004, have been fully considered but they are not persuasive.

#### **First Applicant Argument:**

Applicant states in the first paragraph of page 15 "As such, Call does not disclose 'retrieving the identity of the first entity based on the changed value and one of the one or more update values' as is now recited in claim 1."

#### **First Examiner Response:**

Examiner is not persuaded. Examiner maintains the following disclosure by Call, column 10, lines 46-56 reads on above claim limitation:

This ability to obtain accurate and up-to-date product information from the manufacture can substantially reduce the cost to resellers, catalog producers, and database vendors which is traditionally incurred in capturing this data by conventional means. For example, a retailer creating a computerized inventory control system for the first time with previously purchased merchandise may use a conventional hand-held barcode scanner to capture the universal product codes from all goods in inventory, and then retrieve complete and accurate product description records for each product via the Internet using the present invention.

#### **Second Applicant Argument:**

Applicant states in the second paragraph on page 15 "In addition, Call also does not also disclose 'providing destination data correlating the information codes to entities, storing an entity



Art Unit: 2171

data association .... identifying a first entity based upon the information code associated with the product, the entity-data association and the destination data,' as is now recited in claim 6.”

**Second Examiner Response:**

Examiner is not persuaded. Applicant states on page 15 that Call does not teach the limitations of claim 6. Examiner is perplexed as Call’s disclosure relevant to claim 6, is, element by element, clearly identified element in supra office action. Furthermore, examiner notes Rule 37CFR 1.111(b) requires Applicant to "distinctly and specifically point out errors" in the examiner's action. Also, arguments or conclusions of Applicant cannot take the place of evidence. *In re Cole*, 51 CCPA 919, 326F.2d 769, 140 USPQ 230 (1964).

**Third Applicant Argument:**

Applicant states in the third paragraph on page 15 “With regard to claim 12, Call does not disclose or suggest ‘means for associating the identity of a first vendor with at least [one] of the codes including setting one or more update values that provide an indication whether a vendor is authorized to automatically receive changes to the first or second characteristic values and means for retrieving the identity of the first vendor based on the changed characteristic value and one of the one or more update values.’”

**Third Examiner Response:**

Examiner is not persuaded. Applicant states on page 15 that Call does not teach the limitations of claim 12. Examiner is perplexed as Call’s disclosure relevant to claim 12, is, element by element, clearly identified element in supra office action. Furthermore, examiner notes Rule 37CFR 1.111(b) requires Applicant to "distinctly and specifically point out errors" in the examiner's action. Also, arguments or conclusions of Applicant cannot take the place of evidence. *In re Cole*, 51 CCPA 919, 326F.2d 769, 140 USPQ 230 (1964).

**Fourth Applicant Argument:**

Applicant states in the fourth paragraph on page 15, "With regard to claim 15, Call does not disclose or suggest 'associating the identity of the first entity with at least one of the codes including storing an update value indicating whether the first entity is authorized to automatically receive updates to a characteristic associated with a code ... (and) retrieving the identity of the first entity based on the changed value and the update value.'"

**Fourth Examiner Response:**

Examiner is not persuaded. Applicant states on page 15 that Call does not teach the limitations of claim 15. Examiner is perplexed as Call's disclosure relevant to claim 15, is, element by element, clearly identified element in supra office action. Furthermore, examiner notes Rule 37CFR 1.111(b) requires Applicant to "distinctly and specifically point out errors" in the examiner's action. Also, arguments or conclusions of Applicant cannot take the place of evidence. *In re Cole*, 51 CCPA 919, 326F.2d 769, 140 USPQ 230 (1964).

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

Art Unit: 2171

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Etienne LeRoux whose telephone number is (703) 305-0620.

The examiner can normally be reached on Monday – Friday from 8:00 AM to 4:30 PM.

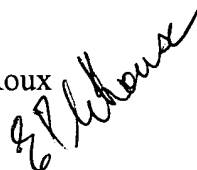
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic, can be reached on (703) 308-1436.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Patent related correspondence can be forwarded via the following FAX number (703) 872-9306

Etienne LeRoux

4/14/2004



SAFET METJAHIC  
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